

REMARKS

After entry of this Amendment, the pending claims are: claims 1-5, 7-16, and 21-31. The Office Action dated February 20, 2007 has been carefully considered. Claims 6 and 17-20 were previously canceled without prejudice. The Applicant hereby explicitly reserves the right to file continuation and/or divisional applications to protect these inventions. Claims 1 and 9 have been amended. Claims 21-31 have been added. No new matter has been added. Reconsideration and allowance of the present application in view of the above Amendments and the following Remarks is respectfully requested.

In the Office Action dated February 20, 2007, the Examiner:

- rejected claims 1, 2, 5, 7, and 8 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,360,405 to Yoon (“Yoon ’405 patent”) in view of U.S. Patent No. 5,882,340 to Yoon (“Yoon ’340 patent”);
- rejected claims 1 and 3 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,066,288 to Deniega *et al.* (“Deniega”) in view of Yoon ’340 patent;
- rejected claims 4, 9, 10, and 12-16 under 35 U.S.C. 103(a) as being unpatentable over Yoon ’405 patent in view of Yoon ’340 patent in view of U.S. Patent No. 5,591,190 to Yoon (“Yoon ’190 patent”); and
- rejected claims 4, and 9-16 under 35 U.S.C. 103(a) as being unpatentable over Deniega in view of Yoon ’340 patent in view of Yoon ’190 patent.

INDEPENDENT CLAIM 1

Independent claim 1 has been rejected as being unpatentable over the Yoon '405 patent in view of the Yoon '340 patent. In addition, independent claim 1 has been rejected as being unpatentable over Deniega in view of the Yoon '340 patent.

As an initial matter, the limitation "wherein there is at least one aperture in the wall of the outer sleeve" has been deleted from independent claim 1 in order to broaden the scope of the claims, which were unnecessarily limited. At least one aperture in the wall of the outer sleeve is not required to distinguish independent claim 1 from the cited prior art.

As amended, independent claim 1 requires, *inter alia*, an awl apparatus comprising: a shaft, an outer sleeve and a biasing member, the distal end of the outer sleeve is sized and configured for releasable attachment to a bone plate. It is respectfully submitted that neither the Yoon '405 patent in combination with the Yoon '340 patent or Deniega in combination with the Yoon '340 patent disclose, teach, or suggest an outer sleeve that is sized and configured for releasable attachment to a bone plate.

As admitted by the Examiner, the Yoon '405 patent and Deniega do not disclose, teach, or suggest an outer sleeve that is sized and configured for releasable attachment to a bone plate. Rather, the Examiner relies upon the Yoon '190 patent to disclose external threads for engaging a bone plate. It is respectfully submitted that the Yoon '190 patent, in connection with Figs. 15 and 16, discloses a cylindrical safety shield body 150 (*i.e.*, outer sleeve) and a trocar tip (*i.e.*, a shaft) wherein the cylindrical safety shield body 150 and trocar tip each include an external helical thread 180, 182. The

helical threads 180, 182 being sized and configured so that when the cylindrical safety shield body 150 is in a retracted position relative to the trocar tip, the helical threads 180, 182 are like handed and extend in the same angular direction so that the threads on the trocar tip and the threads on the cylindrical safety shield body 150 form a continuous thread extending around the trocar tip and cylindrical safety shield body 150 so that the distal end of the trocar can be rotated into the patient's tissue.

It is respectfully submitted that the Yoon '190 patent does not disclose, teach, or suggest an outer sleeve that is sized and configured for releasable attachment to a bone plate. In fact, there is absolutely no disclosure or mention of a bone plate in the Yoon '190 patent, the Yoon '405 patent, the Yoon '340 patent and/or Deniega. At best, the Yoon '190 patent discloses a trocar assembly that includes an external thread formed on both the shaft and on the outer sleeve for rotating the trocar into a patient's body to form a hole in the patient's tissue. It is respectfully submitted that threadedly engaging the device of the Yoon '190 patent into a bone plate would render the device inoperative since the trocar tip would no longer be moveable with respect to the cylindrical safety shield body. Thus, it is respectfully submitted that neither the Yoon '405 patent in combination with the Yoon '340 patent or Deniega in combination with the Yoon '340 patent disclose, teach, or suggest all of the limitations of independent claim 1. Thus, it is respectfully submitted that independent claim 1 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 1 is respectfully requested.

Furthermore, as claims 2-5, 7 and 8 all depend from independent claim 1, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 2-5, 7 and 8 is also respectfully requested.

INDEPENDENT CLAIM 9

Independent claim 9 was rejected as being unpatentable over the Yoon '405 patent in view of the Yoon '340 patent in view of the Yoon '190 patent. In addition, independent claim 9 was rejected as being unpatentable over Deniega in view of the Yoon '340 patent in view of the Yoon '190 patent.

As an initial matter, the limitation "wherein there is at least one aperture in the wall of the outer sleeve" has been deleted from independent claim 9 in order to broaden the scope of the claims, which were unnecessarily limited. At least one aperture in the wall of the outer sleeve is not required to distinguish independent claim 9 from the cited prior art.

As amended, independent claim 9 requires, *inter alia*, an awl apparatus comprising a shaft having a cutting edge formed on a distal end; an outer sleeve wherein the outer sleeve surrounds at least a portion of the shaft, an inner sleeve wherein at least a portion of the inner sleeve is located in between the shaft and the outer sleeve; and a biasing member configured to bias the shaft to an initial position within the outer sleeve, wherein the biasing member surrounds at least a portion of the shaft and is located in between the outer sleeve and the distal end of the inner sleeve.

It is respectfully submitted that neither the Yoon '405 patent in combination with the Yoon '340 patent in further combination with the Yoon '190 patent or Deniega in combination with the Yoon '340 patent in further combination with the Yoon '190 patent disclose, teach, or suggest a biasing member wherein the biasing member surrounds at least a portion of the shaft and is located in between the outer sleeve and the distal end of the inner sleeve.

Thus, it is respectfully submitted that neither the Yoon '405 patent in combination with the Yoon '340 patent in further combination with the Yoon '190 patent or Deniega in combination with the Yoon '340 patent in further combination with the Yoon '190 patent disclose, teach, or suggest all of the limitations of independent claim 9. Thus, it is respectfully submitted that independent claim 9 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 9 is respectfully requested.

Furthermore, as claims 10-16 all depend from independent claim 9, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 10-16 is also respectfully requested.

NEWLY ADDED INDEPENDENT CLAIM 21

Newly added independent claim 21 requires, *inter alia*, an awl assembly comprising a bottom outer sleeve having a distal end, wherein the distal end of the bottom outer sleeve is sized and configured to releasably engage an anchor hole of a bone plate.

As previously described above in connection with independent claim 1, it is respectfully submitted that the cited prior art does not disclose, teach, or suggest a bottom outer sleeve having a distal end, wherein the distal end of the bottom outer sleeve is sized and configured to releasably engage an anchor hole of a bone plate. In fact, there is absolutely no disclosure or mention of a bone plate in the Yoon '190 patent, the Yoon '405 patent, the Yoon '340 patent and/or Deniega. At best, the Yoon '190 patent discloses a trocar assembly that includes an external thread formed on both the shaft and on the

outer sleeve for rotating the trocar into a patient's body to form a hole in the patient's tissue. It is respectfully submitted that threadedly engaging the device of the Yoon '190 patent into a bone plate would render the device inoperative since the trocar tip would no longer be moveable with respect to the cylindrical safety shield body. Thus, it is respectfully submitted that cited prior art does not disclose, teach, or suggest all of the limitations of newly added independent claim 21.

Moreover, newly added independent claim 21 requires, *inter alia*, an awl assembly comprising a top outer sleeve having a throughbore, a bottom outer sleeve having a proximal end, said proximal end of said bottom outer sleeve being sized and configured to releasably engage said top outer sleeve; an inner sleeve, said inner sleeve being sized and configured to be at least partially received within the throughbore of the top outer sleeve; and an awl shaft, said awl shaft being sized and configured to be slideably disposed within inner sleeve, the top outer sleeve and the bottom outer sleeve.

It is respectfully submitted that there is absolutely no disclosure in the cited prior art of a two-piece outer sleeve as required by newly added independent claim 21. Therefore, it is respectfully submitted that cited prior art does not disclose, teach, or suggest all of the limitations of newly added independent claim 21 for at least this reason as well.

For at least the above-identified reasons, it is respectfully submitted that the cited prior art does not disclose, teach or suggest all of the limitations of newly added independent claim 21. Thus, it is respectfully submitted that newly added independent claim 21 is allowable over the cited prior art. Allowance of independent claim 21 is respectfully requested.

Furthermore, as newly added dependent claims 22-31 all depend from independent claim 21, it is submitted that these claims are equally allowable. Allowance of claims 22-31 is also respectfully requested.

CONCLUSION

A fee of \$300 is believed due with this submission for the addition of six new claims (26 total pending claims minus 20). The Commissioner is authorized to charge this and any other fee which may now or hereafter be due in this application to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

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Respectfully submitted,

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